

REMARKS

Applicant has amended claim 1 to further clarify novel features of the claimed metal working fluid. The claim amendment is supported by the as-filed specification, e.g., paragraphs [0028] and [0127], and Tables 1 and 6. No new matter has been introduced.

Applicant has amended claim 14 to replace the term "in" with "is," thereby rendering moot the objection to claim 14. Applicant also has amended claims 11-18 to correctly depend from claim 10, thereby rendering moot the objection to claims 11-18.

Applicant respectfully traverses the 35 U.S.C. § 102(b) rejection of claims 10-18 over U.S. Patent No. 6,383,992 to Garmier et al. ("Garmier").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131.

Amended claim 10 recites, among other things, an oil for metal working comprising a triester of fatty acids and glycerin, a total degree of unsaturation of the triester being no greater than 0.3.

Garmier does not disclose or suggest at least a total degree of unsaturation of a triester, and thus neither discloses nor suggests a total degree of unsaturation of the triester being no greater than 0.3.

Since Garmier fails to discloses all of the features of amended claim 10, amended claim 10 and its dependent claims are not anticipated by Garmier.

Applicant also respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 15-18 over Garmier in view of U.S. Patent Application Publication No. 2002/0035043 to Yokota et al. ("Yokota").

To establish a prima facie case of obviousness, the prior art reference or references when combined must teach or suggest all of the claim limitations. M.P.E.P § 2143.

As discussed above, Garmier fails to disclose or suggest the above-mentioned features of amended claim 10. Yokota does not remedy this deficiency in Garmier, because Yokota also does not disclose or suggest a total degree of unsaturation of a triester, and thus neither discloses nor suggests a total degree of unsaturation of the triester being no greater than 0.3.

Since neither Garmier nor Yokota, alone or in combination, discloses or suggests all of the features of amended claim 10, amended claim 10 is not obvious over the cited references. Claims 15-18 depend from claim 10 and incorporate all of the features of amended claim 10. Claims 15 -18 therefore also are not obvious at least due to their respective dependence from amended claim 10.

Furthermore, to establish a prima facie case of obviousness, a reasonable expectation of success is required. M.P.E.P. § 2143.02. To support that a claim would have been obvious, a proposed combination would have yielded nothing more than predictable results to one of ordinary skill in the art. See M.P.E.P. § 2143.02.

As disclosed in Tables 2-5 of the as-filed specification, the claimed oil for metal working with a total degree of unsaturation of the triester being no greater than 0.3 has unexpected beneficial results, i.e., superior anti-sticking property, in comparison with

examples with a total degree of unsaturation of a triester greater than 0.3. For examples, Examples 1-18, wherein a total degree of unsaturation is not greater than 0.3, display superior anti-sticking properties in comparison with Comparative Example 2, wherein a total degree of unsaturation is greater than 0.3. Because, based on the cited references, one skilled in the art would not have had a reasonable expectation of success or have achieved predictable results in using a metal working fluid wherein a total degree of unsaturation of a triester is no greater than 0.3, as recited in amended claim 1, no prima facie case of obviousness is established.

Applicant respectfully traverses the rejection of claims 10-18 for alleged obviousness-type double patenting over claims 6-9 of Application No. 12/076,978. Nevertheless, in order to move this case forward, Applicant submits herewith a Terminal Disclaimer, rendering the rejection moot.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application, withdrawal of the rejections, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 19, 2009

By: _____


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Attachment: Terminal Disclaimer